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In re Application of
NIZZERE et al
U.S. Application No.: 10/590,815
PCT No.: PCT/US2005/006414
Int. Filing Date: 28 February 2005
Priority Date: 27 February 2004
Docket No.: 074408.9007-01
For: SCALE

**DECISION ON
PETITION
UNDER 37 CFR 1.47(a)**

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 03 December 2007.

BACKGROUND

On 01 May 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a \$130.00 surcharge fee must be provided. Applicants were given two months to respond.

On 03 December 2007, applicants submitted the subject petition which was accompanied by, *inter alia*, a petition fee of \$200.00; the surcharge fee of \$130.00; a five-month extension fee of \$2,230.00; a declaration executed by five of the seven named inventors; a declaration of Karen Kaplan; and exhibits A-B.

DISCUSSION

Petitioners allege that Matthew Lawler and Theron Kotze cannot be located. As such, a petition under 37 CFR 1.47(a) was filed as response to the Notification of Missing Requirements.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application or cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the \$200.00 petition fee has been paid.

With regard to item (3), the 37 CFR 1.47(a) applicants satisfies this requirement by listing the last known addresses of both nonsigning inventors.

However, petitioners have not yet met the requirements for items (2) and (4) of 37 CFR 1.47(a).

Concerning item (2), Petitioners must follow the procedures outlined in section 409.03(d) of the MPEP whereby the inventor cannot be reached which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. **Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement.** The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

In this case, petitioners have provided evidence that would be meet the 'diligent effort' standard of the MPEP if corroborated by sufficient documentary evidence. However, petitioners only submitted copies of the Federal Express tracking documents as discussed in the declaration of Ms. Kaplan. Petitioners must also provide copies of the internet searches conducted and any other relevant documentary evidence for a grantable petition. See above *in bold*.

For this reason, item (2) of 37 CFR 1.47(a) is not yet satisfied.

Regarding item (4), petitioners included a declaration signed by five of the seven joint inventors listed on the international publication. All required information including the nonsigning co-inventors' names, residences, post office addresses and citizenship are typed on the declaration. Nevertheless, the declaration does not meet the requirements of 37 CFR 1.497(a) and (b).

It appears that petitioners submitted one complete declaration and a portion of another declaration. The declaration submitted contains two page 4's. While each

inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. By providing only a partial declaration, it is not clear what inventive entity was listed on the declaration signed by each co-inventor.

Moreover, the declaration contains noninitialed changes in ink on the declaration regarding the address of joint inventor, Chris Kulujian. Any changes made in ink must be initialed and dated by the applicants prior to execution of the declaration. The Office will not consider whether noninitialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP § 605.04(a).

For these reasons, item (4) of 37 CFR 1.47(a) is also not satisfied.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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